

REMARKS

Claims 1 to 18 are pending. Claim 14–18 are added.

Support for new claim 14 can be found, for instance, at page 2, lines 25–27; page 10, lines 10–14; page 10, lines 24–26; and claim 1 as originally filed. Support for new claims 15–18 can be found at page 2, lines 12–19; page 10, lines 9–13; page 10, lines 23–25; and in claims 76–78 as originally filed in Application No. 09/862,022 (which the present application incorporates by reference).

§ 112 Rejections

Claims 1–13 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant's regard as the invention.

The Patent Office asserts that claim 1 is indefinite because it is directed to a method of bonding to a substrate and the body of the claim does not mention a substrate or a separate step of “bonding”.

As explained in MPEP § 2111.02, when the “body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction.”

The Applicants respectfully submit that claim 1 as originally filed is not indefinite and that one of ordinary skill in the art could readily ascertain the scope of the claimed subject matter. The terms “bonding” and “substrate”, provided in the preamble, simply designate an intended use for the method described. These terms do not represent a claim limitation and are of no significance to the construction of claim 1.

The Applicants submit that the Patent Office rejection is a result of an inappropriate reading of the preamble into the body of the claim. Therefore, the Applicants kindly request that this rejection be withdrawn.

Claims 2–13 are rejected by virtue of being dependent from rejected claim 1. The Applicants kindly submit that having overcome the rejection of claim 1, the rejection of claims 2–13 have similarly been overcome. Applicants request withdrawal of this rejection of claims 2–13.

In order to further facilitate prosecution, the Applicants have added new claim 14 for consideration. Claim 14 contains language comparable to that suggested by the Examiner in paragraph 4 of the Office Action.

In summary, the Applicants submit that the rejection of claims 1–13 under 35 USC § 112, second paragraph, has been overcome, and that the rejection should be withdrawn.

Double Patenting Rejection

Claims 1–13 are rejected under the judicially created doctrine of obviousness-type double patenting as purportedly being obvious over claims 1–29 of U.S. Patent No. 6,630,047.

The Applicants respectfully submit that this double patenting rejection is improper under the third sentence of 35 U.S.C. § 121 and MPEP § 804.01.

The third sentence of 35 U.S.C. § 121 provides that “A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.”

As explained in MPEP § 804.01, this provision “prohibits the use of a patent issuing on an application filed as a result of such a [restriction] requirement, as a reference against any divisional application, if the divisional application is filed before the issuance of the patent.”

The present application was filed on September 19, 2003. Original claims 1–13 correspond substantially to claims 46–58 in Application No. 09/862,022 (now U.S. Patent 6,630,047), of which the present application is a divisional.

Claims 1–13 were subject to a restriction requirement dated September 25, 2002 (Paper #7) in Application No. 09/862,022. Claims 1–13, then claims 46–58, were restricted to Group II. The Applicants chose to prosecute the claims of Group I (Response dated October 25, 2002 in

Application No. 09/862,022) and subsequently filed the present divisional application directed to Group II claims.

The Patent Office subsequently grouped claims 19, 20, and 76-79 into Group II of Application No. 09/862,022. New claims 15-18 correspond to claims 76-79, grouped by the Patent Office into Group II, and subject to the restriction requirement in Application No. 09/862,022. Accordingly, the Applicants kindly submit that these claims are entitled to the same consideration as those originally filed in the present application.

In view of the above, it is submitted that the Double Patenting rejection is inappropriate. Applicants respectfully request that it be withdrawn.

The Applicants submit that the Application is in condition for allowance. Reconsideration of the application is requested.

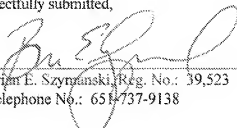
In the event that the Examiner finds it helpful to the continuing prosecution of the present application, the Applicants representative invites the Examiner to contact him at the below-provided telephone number.

Respectfully submitted,

December 19, 2005

Date

By:


Brian E. Szymanski, Reg. No.: 39,523
Telephone No.: 651-737-9138

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833